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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,588	03/30/2001	S. Sean Moore	UV/192	6830
1473 7590 07/10/2009 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER LASTRA, DANIEL	
			ART UNIT 3688	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/823,588

**Applicant(s)**

MOORE ET AL.

**Examiner**

DANIEL LASTRA

**Art Unit**

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6-10,12-18,20-24,26-37,40-43,45-48 and 50-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-10,12-18,20-24,26-37,40-43,45-48 and 50-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1, 2, 6-10, 12-18, 20-24, 26-37, 40-43, 45-48 and 50-63 have been examined. Application 09/823,588 (SYSTEM AND METHOD FOR METADATA-LINKED ADVERTISEMENTS) has a filing date 03/30/2001 Claims Priority from Provisional Application 60193948, filed 03/31/2000.

### **Response to Amendment**

2. In response to Final Rejection filed 01/06/2009, the Applicant filed an RCE on 04/23/2009, which amended claims 1, 12-14, 18, 26-28, 32, 36, 37, 43, 48, 53-62.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 12-14, 18, 26-28, 32, 36, 37, 43, 48, 53-57, 59-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 12-14, 18, 26-28, 32, 36, 37, 43, 48, 53-57, 59-62 recite "selecting a subplurality of advertisements based on the metadata associated with the media; receiving at the user equipment the subplurality of advertisements". Nowhere, in Applicant's specification is recited anything a subplurality of advertisements.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 12-14, 18, 26-28, 32, 36, 37, 43, 48, 53-57, 59-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims are indefinite because the Applicant is adding to the claims the term "subplurality" that it is not explained or described in the Applicant's specification. Nowhere in Applicant's specification is recited that a subplurality of advertisements is selected based on the metadata associated with the media, receiving at the user's equipment the subplurality of advertisements, and comparing at the user equipment the metadata associated with an object selected by a user with the metadata associated with each of the subplurality of advertisements. The Applicant is adding new matter to the specification when he is adding that from a plurality of claims is selecting a subplurality and then from said subplurality is selecting an ad to display. Applicant's specification has support for receiving at a user's equipment media comprising at least one object, metadata associated with the media, metadata associated with at least one object, advertisements and metadata associated with said advertisements and then for example, when media and/or a selectable object within the media is selected, the metadata attached to and/or associated with the media and/or selectable object may be read, then an advertisement corresponding the metadata read be selected. The advertisement may be selected by comparing the metadata of the media or selected

object with metadata from advertisements. The advertisements may be provided from a suitable remote location to the user's equipment (e.g. metadata may contain a source address URL) or may be provided from advertisements previously stored on the user's system (see Applicant's specification page 12, line 10 – page 13, line 2).

Claims 18 recites the limitation "the user equipment". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 8-10, 12, 13, 15-18, 20, 22-24, 26, 27, 29, 30-34, 36, 37, 40, 42-43, 45, 47-48, 50, 52-57 and 59-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Reilly (US 5,740,549).

As per claims 1, 18, 32, 36, 37, 43, 48 and 53, Reilly teaches:

A method executed by at least one computer processor for providing an advertisement selected from a plurality of advertisements each associated with its own metadata, comprising:

receiving at user equipment media comprising at least one object *metadata associated with the media*, metadata associated with the at least on object and the metadata associated with each of the plurality of advertisements (see column 2, line 60 – col 3, line 10);

*selecting a subplurality of advertisements based on the metadata associated with the media (see col 3, lines 1-10 "subset"; col 12, lines 1-20 "metadata is the category of the media")*

receiving at the user equipment the subplurality of advertisements (see col 3, lines 1-10);

displaying the media and the at least one object on a viewing device at the user equipment (see col 13, line 30 – col 14, line 10);

receiving a user selection of the at least one object displayed on the viewing device (see column 13, line 30 – col 14, line 10);

comparing at the user equipment the metadata associated with the object selected by the user with the metadata associated with each of the subplurality of advertisements (see column 13, lines 60-67); and

selecting at the user equipment one of the subplurality of advertisements based on the comparison (see column 13, lines 60-67)

displaying the selected advertisement on a viewing device (see col 13, lines 60-67);

monitoring the selected advertisement, collecting data on the selected advertisement and recording the data (see col 5, line 60 – col 6, line 15).

As per claim 2, Reilly teaches:

displaying the selected advertisement on the viewing device (see column 13, lines 60-67).

As per claims 6, 20, 40, 45 and 50, Reilly teaches:

wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are received on a broadcast channel on which the media is also received (see column 4, lines 1-15).

As per claims 8, 22, 42, 47 and 52, Reilly teaches:

storing the metadata associated with the at least one object and the metadata associated with the plurality of advertisements (see column 3, lines 1-15; figure 9 "category").

As per claims 9 and 23, Reilly teaches:

wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are stored on a single storage device (see col 6, lines 45-60).

As per claims 10 and 24, Reilly teaches:

wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are stored on a plurality of storage devices (see col 6, lines 1-25 "information server and workstation").

As per claims 12 and 26, Reilly teaches:

wherein the subplurality of advertisements are received within the media (see column 3, lines 1-15).

As per claims 13 and 27, Reilly teaches:

wherein the subplurality of advertisements are received on a broadcast channel on which the media is also received (see column 4, lines 1-20).

As per claims 15 and 29, Reilly teaches:

storing the selected advertisement (see column 3, lines 1-15).

As per claims 16 and 30, Reilly teaches:

wherein the selected advertisement is stored on a single storage device (see col 6, lines 45-60).

As per claims 17 and 31, Reilly teaches:

wherein the selected advertisement is stored on a plurality of storage devices (see col 6, lines 1-25 "information server and workstation").

As per claim 33, Reilly teaches:

wherein the metadata associated with the object and the metadata associated with the plurality of advertisements further contain at least one source address (see column 13, lines 15-25).

As per claim 34, Reilly teaches:

wherein at least one of the at least one source address is a Uniform Resource Locator (see column 13, lines 15-25).

Claim 54, Reilly teaches:

periodically receiving the subplurality of advertisements from one or more remote locations (see col 8, lines 20-45).

Claim 55, Reilly teaches:

receiving the subplurality of advertisements from one or more remote locations in response to requests made by the user equipment (see col 8, lines 20-50).

Claim 56, Reilly teaches:



polling one or more remote location for the subplurality of advertisements (see col 8, lines 20-50).

Claim 57, Reilly teaches:

storing the subplurality of advertisements at the user equipment (see col 6, lines 45-67).

Claim 59, Reilly teaches:

wherein the at least one receiver periodically receives the subplurality of advertisements from one or more remote locations (see col 8, lines 20-60).

Claim 60, Reilly teaches:

wherein the at least one receiver receives the subplurality of advertisements from one or more remote locations in response to requests made by the processor (see col 8, lines 20-60).

Claim 61, Reilly teaches:

wherein the processor is configured to poll one or more remote locations for the subplurality of advertisements (see col 8, lines 20-60).

Claim 62, Reilly teaches:

at least one storage unit for storing the subplurality of advertisements at the user equipment (see col 4, lines 40-65).

#### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 14, 21, 28, 41, 46, 51, 58 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (US 5,740,549) in view of Srinivasan et al (U.S. 6,357,042).

As per claims 7, 21, 41, 46 and 51, Reilly does not teach:

wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are received on a separate broadcast channel from the media. However, Srinivasan teaches a system where Internet streaming may be performed with metadata being streamed independently while a main video arrives separately (see column 37, lines 55-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Reilly would Internet stream to the user's workstation the metadata of the object and advertisements (i.e. categories) separately from the media (i.e. news stories) in view that Srinivasan teaches that it is old and well known in the communication art to transmit metadata independently from a media.

As per claims 14 and 28, Reilly does not teach:

wherein the subplurality of advertisements are received on a separate broadcast channel from the media. However, Srinivasan teaches a system where Internet streaming may be performed with metadata being streamed independently while a main video arrives separately (see column 37, lines 55-67). Therefore, it would have been

obvious to a person of ordinary skill in the art at the time the application was made, to know that Reilly would Internet stream to the user's workstation the metadata of the object and advertisements (i.e. categories) separately from the media (i.e. news stories) in view that Srinivasan teaches that it is old and well known in the communication art to transmit metadata independently from a media.

Claims 58 and 63, Reilly does not teach:

ordering one or more items displayed by the selected advertisement. However, Srinivasan teaches that it is old and well known in the promotion art to order items displayed by a selected advertisement (see col 32, lines 35-40). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Reilly would allow users to order items from displayed advertisements, as Srinivasan teaches that it is old and well known to do so.

7. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (US 5,740,549).

As per claim 35, Reilly does not teach:

wherein at least one source address is a telephone number. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Reilly would include in the source address the advertiser's telephone number therefore giving users the advertiser's contact information.

### ***Response to Arguments***

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The Applicant argues that Reilly does not

show selecting an advertisement for display based on a comparison of metadata associated with an object contained in media because according to the Applicant, Reilly shows selecting advertisements in a rotating order from a group of pre-assigned advertisements. The Examiner answers that Reilly teaches assigning metadata (i.e. category) to each news item in a plurality of news items and to each advertisement in a plurality of advertisements (see figure 8) and selecting an advertisement to display to a user on the basis of comparing the metadata (i.e. category) associated with a news item being viewed by said user with the metadata (i.e. category) of each advertisement from the plurality of advertisements (see col 13, line 60-67). Therefore, contrary to Applicant's argument, Reilly teaches Applicant's claimed invention.

The Applicant argues that in Reilly, because a user clicks on a information category button to select a news item in the selected information category, the object selected, according to the Applicant, is not the object associated with metadata and therefore, according to the Applicant, Reilly does not show selecting an advertisement based on a comparison that includes the metadata of a user selected object. The Examiner answers that the Applicant is arguing about limitation not stated in the claims. Applicant's claims recite "receiving a user selection of the at least one object displayed on the viewing device; comparing at the user equipment the metadata associated with the object selected by a user with the metadata associated with each of subplurality of advertisements and selecting at the user equipment one the subplurality of advertisements based upon on the comparison". Nowhere, in Applicant's claims is recited that said selection of said object cannot be done by selecting a category button

first, therefore, because a user in the Reilly's system clicks a category button to select a news item would not obviate the fact that a news item is still selected and being viewed by a user and the Reilly's system selects an advertisement to display to said user on the basis of comparing the category of the news item being selected and viewed by said user with the category of an advertisement (see col 13, lines 60-67). Therefore, contrary to Applicant's argument, Reilly teaches Applicant's claimed invention.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
July 8, 2009